REMARKS

Initially, Applicants have amended claims 211, 222, 280-282, 289-296, 298-299, and 301 to more accurately claim the present invention and not for any reason related to patentability. No new matter has been added. Applicants believe that the following comments will convince the Examiner that the rejections set forth in the January 22, 2003 Office Action have been overcome and should be withdrawn.

I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed official document comprising at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. In the present invention, a machine recognizable feature is scanned or sensed, and converted into an electronic signal, which is transmitted for processing. In response to the electronic signal, programming material related to the information contained in the official document is displayed. Importantly, the

present invention is designed to allow a user to access programming material related to the official document.

II. THE EXAMINER'S REJECTIONS

A. DOUBLE PATENTING

The Examiner rejected claims 168, 296, and 299 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,932,863 (hereinafter referred to as "the '863 patent").

> "Although the scope of claims 168, 296 and 299 of the present application and claim 1 of [the] '863 patent are almost identical, the difference between the present claimed invention and the '863 is that the present claimed invention is a broader recitation of the '863 patent." (January 22, 2003 Office Action Summary, p. 3, paragraph 2).

Also, the Examiner provisionally rejected claims 168, 197-248, 257-260, and 265-301 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 168-221 and 224-263 of co-pending application Ser. No. 09/769,149 (hereinafter referred to as "the '149 application").

"Although the scope of claims 168, 197-248, 257-260 and 265-301 of the present application and claims 168-221 and 224-263 of [the] '149 application are almost identical, the difference between the present claimed invention and the '149 application is that the present claimed invention is a narrower recitation of the '149 application." (January 22, 2003 Office Action Summary, p. 5, paragraph 3).

B. 35 U.S.C. § 103

The Examiner rejected claims 168-201, 204-206, 223-224, 240, 249-256, 261-264, 267-270, 275-277, 280, 291, 296, and 298-301 under 35 U.S.C. § 103(a) as being unpatentable over Withnall *et al.* U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall") in view of Fields U.S. Patent No. 4,481,412 (hereinafter referred to as "Fields") and Li *et al.* U.S. Patent No. 5,506,697 (hereinafter referred to as "Li"). The Examiner opined that Withnall discloses a system that includes a feature recognition device that reads at least one machine recognizable feature on a travel ticket to display information on the display of a portable handset. However, the Examiner admitted that:

"Withnall et al fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal." (January 22, 2003 Office Action Summary, p. 7, paragraph 6).

The Examiner contended that Fields teaches these features by disclosing a microcontroller accessing means that includes a "barcode electronic circuit" coupled to a barcode reader, wherein the microcontroller accesses and transmits programming material in response to receiving a coded signal. The Examiner argued that the system disclosed in Fields displays "video/image/programming/ sound/pictorial/electronic/media data" on a "television/ workbook."

The Examiner stated that combining the systems disclosed in Withnall and Fields would have been obvious at the time of Applicants' invention to provide:

"Withnall et al with a higher technology system wherein the user being provided with a full

complete [sic] information in a flexible ways [sic] … such modification would have been an obvious extension as taught by Withnall et al." (January 22, 2003 Office Action Summary, p. 7, paragraph 6).

The Examiner then admitted that the Withnall and Fields combination fails to teach or suggest a printed official document, which is argued to be taught by Li. The Examiner stated that combining Li with Withnall and Fields would have been obvious for providing:

"a more secure system wherein official documents can be prevented from being accessed by an unauthorized person due to the benefit of [a] machine recognizable symbol/barcode, and thus providing a more user-friendly system wherein the user does not have to [be] concern[ed] about his/her lost/stolen official document is read [sic] by [a] fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields." (January 22, 2003 Office Action Summary, p. 8, paragraph 6).

The Examiner then admitted that Withnall, Fields, and Li fail to disclose a printed official document that is a license, registration, passport, visa, Green Card, license

plate, tag, decal, parking permit, Social Security Card, health insurance card, Medicaid card, deed, invoice, receipt, bill of sale, library card, newsletter, application form, lottery ticket, etc. The Examiner asserted that modifying the Withnall, Fields, and Li combination to use such official documents would have been:

> "a substitution of a functional equivalent which does not change the underlying inventiveness of Withnall et al/Fields/Li et al's teachings. Furthermore such modification would have been an obvious design variation." (January 22, 2003 Office Action Summary, p. 8, paragraph 6).

Also, the Examiner rejected claims 202-203, 208-210, 212, 217-218, 220-221, and 242-247 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Li "as applied to claim 168" in view of Roberts U.S. Patent No. 5,324,922 (hereinafter referred to as "Roberts") and Malec *et al.* U.S. Patent No. 5,287,266 (hereinafter referred to as "Malec"). The Examiner admitted that Withnall, Fields, and Li fail to teach online or home shopping and a cable television data link, and argued that these features are disclosed by Roberts. According to the Examiner, the combination of Roberts with Withnall, Fields, and Li would have been obvious and would provide:

"a faster internet system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Li et al to provide the user [with] an alternative way of conducting shopping at his/her convenience." (January 22, 2003 Office Action Summary, p. 9, paragraph 7).

Moreover, the Examiner admitted that Withnall, Fields, Li, and Roberts all fail to disclose an Integrated Services Digital Network ("ISDN") data link which, according to the Examiner, is disclosed by Malec. In the opinion of the Examiner, the combination of Malec with Withnall, Fields, Li, and Roberts would have been obvious for providing:

"a more accurate and faster system due to the benefit of ISDN networking line[s]. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Li et al/Roberts and would have mere[ly] been a substitution of equivalents." (January 22, 2003 Office Action Summary, pp. 9-10, paragraph 7.

Next, the Examiner rejected claims 207, 210, 214-216, 219, 222, 227-229, 231-232, 237-238, 241, 249-260, 265-266, 274, 279, 281-283, 294, and 297 under 35 U.S.C. § 103(a) as

being unpatentable over Withnall as modified by Fields and Li "as applied to claims 168 and 296" in view of Bravman *et al.* U.S. Patent No. 5,401,944 (hereinafter referred to as "Bravman"). The Examiner admitted that Withnall, Fields, and Li fail to teach displaying information on a wireless communication device. According to the Examiner, Bravman teaches a remote unit providing travel-related information, and the combination of Withnall, Fields, Li, and Bravman would have been obvious for providing:

> "a more flexibility system [sic] wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Li et al." (January 22, 2003 Office Action Summary, p. 10, paragraph 8).

Also, the Examiner rejected claims 225, 230, and 233 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Li "as applied to claim 168" in view of Waterbury German Patent No. DT 24 52 202 A1 (hereinafter referred to as "Waterbury"). The Examiner admitted that Withnall, Fields, and Li fail to teach an

invisible machine recognizable feature, which is argued to be taught by Waterbury. The Examiner asserted that the combination of Waterbury with Withnall, Fields, Li would have been obvious for providing:

> "a greater security system [sic] wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, and thus preventing an unauthorized individual(s) from manipulating the data. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Li et al." (January 22, 2003 Office Action Summary, p. 11, paragraph 9).

Additionally, the Examiner rejected claims 226 and 240 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Li "as applied to claim 168" in view of Tannehill *et al.* U.S. Patent No. 5,158,310 (hereinafter referred to as "Tannehill"). The Examiner admitted that Withnall, Fields, and Li fail to teach a magnetic code strip, which is argued to be taught by Tannehill. According to the Examiner, the aforementioned combination would have been obvious for providing Withnall, Fields, and Li with an alternative method for encoding data. "Furthermore, such modification would have been

merely a substitution of equivalents." (January 22, 2003 Office Action Summary, p. 12, paragraph 10).

Also, the Examiner rejected claims 234-236, and 239 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Li "as applied to claim 168" in view of Schach *et al.* U.S. Patent No. 5,397,156 (hereinafter referred to as "Schach") and Waterbury. The Examiner admitted that Withnall, Fields, and Li fail to teach a watermark, which is argued to be taught by Schach. In the Examiner's opinion, the combination of Schach with Withnall, Fields, and Li would have been obvious for aesthetic purposes. "[S]uch modification would have been an obvious extension as taught by Withnall et al/Fields/Li et al." (January 22, 2003 Office Action Summary, p. 12, paragraph 11).

The Examiner then admitted that Withnall, Fields, Li, and Schach fail to teach an invisible watermark, which is argued to be taught by Waterbury. The Examiner asserted that the combination of Withnall, Fields, Li, Schach, and Waterbury would have been obvious for providing:

> "a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, thus preventing manipulating by [a] fraudulent user. Furthermore, such

modification would have been an obvious extension as taught by Withnall et al/Fields/Li et al/Schach et al." (January 22, 2003 Office Action Summary, p. 13, paragraph 11).

Also, the Examiner rejected claims 213, 271-273, 278-279, 284-290, 292-293, and 295 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Li "as applied to claim 168" in view of Morales U.S. Patent No. 5,872,589 (hereinafter referred to as "Morales"). The Examiner admitted that Withnall, Fields, and Li fail to teach a display unit comprising a "personal planner/phone/pager," which is argued to be taught by Morales. In the Examiner's opinion, combining Withnall, Fields, Li, and Morales would have been obvious to provide:

> "the user with the flexibility of selecting his/her desired display unit that is fitting [sic] his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Li et al." (January 22, 2003 Office Action Summary, pp. 13-14, paragraph 12).

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

A. DOUBLE PATENTING

The Examiner rejected claims 168, 296, and 299 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the '863 patent. In response, Applicants are filing a Terminal Disclaimer herewith to overcome the Examiner's double patenting rejection.

Also, the Examiner provisionally rejected claims 168, 197-248, 257-260, and 265-301 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 168-221 and 224-263 of the '149 application. In response, Applicants are filing a Terminal Disclaimer herewith to overcome the Examiner's double patenting rejection.

B. 35 U.S.C. § 103

The Examiner rejected claims 168-201, 204-206, 223-224, 240, 249-256, 261-264, 267-270, 275-277, 280, 291, 296, and 298-301 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Fields and Li. Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of Withnall, Fields, and Li. In order for a claimed invention to be obvious in view of a combination of references, three

criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. (see *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991))(see also Manual of Patent Examining Procedure §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify or combine Withnall, Fields, and Li exists.

> "Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

The Examiner contended that it would have been obvious to combine the teachings of Withnall, Fields, and Li to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has cited only purported benefits of this combination without pointing to what motivation is provided by the references themselves. Applicants submit that no combination of these references would have been obvious to

one of skill in the art at the time of Applicants' invention. Specifically, Withnall discloses a system for easing the examination of commuter tickets for validity. This purpose is far removed from the intent of the training system disclosed by Fields. The training system of Fields is used to provide a user with audio/visual output from a videodisc player coinciding with material presented in a training manual. Neither Withnall nor Fields relate to Li, which teaches the use of two-dimensional bar codes to store document information such that the bar code can be scanned and the contained information can be transmitted to a remote location. The differing purposes of these references have no overlap in use, and therefore, would not provide one skilled in the art with a motivation or suggestion to combine these references. Thus, an inventive step must be performed for one skilled in the art to arrive at the idea of combining any features of Withnall, Fields, and Li in any combination.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v.

Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

> "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

Applicants submit that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

In addition to the lack of suggestion or motivation to combine Withnall, Fields, and Li, there is no expectation of success for the combination of these references, and any possible resulting device would not teach or suggest all of the limitations of the rejected claims. Withnall discloses a machine capable of scanning a bar code on a commuter

ticket and subsequently displaying the validity of the ticket based on information stored in a memory means. Fields discloses a system for reading a bar code on a training manual for playing corresponding material from a videodisc. Li discloses a system for reading document information from within a two-dimensional bar code for transmission via facsimile. Applicants respectfully submit that the combination of Withnall, Fields, and Li cannot be successfully combined to disclose the means for accessing programming material associated with a database or the printed stationary having a machine recognizable feature of the claimed invention. Importantly, claims 168, 296, and 299 all disclose the accessing of programming material resulting from recognition of a machine recognizable feature. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user will be provided with the most recently updated version of the associated information (or programming material) upon scanning an official document. This is not possible with the combination of Withnall, Fields, and Li. Any attempt of implementing the videodisc player of Fields with Withnall would require the videodisc player to be located on a vehicle, e.g., a bus. Therefore, anytime information must be updated, a new

videodisc must be inserted into the videodisc player. This is not feasible, especially because the validity of a ticket can change each time a ticket is used and could require a new videodisc to be employed every time a ticket is used. Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player or other such audio/visual material because the radio data link is designed only for transmitting a validity state and not substantially different audio/visual material. In particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus, a system for achieving such transmission would need to be invented and implemented for remotely accessing such material. Moreover, the addition of Li to Withnall and Fields would not be successful because the Li is designed to transmit information actually contained in a document from within a bar code to a remote site. Thus, the system must be reconfigured to transmit information from within a bar code to access programming material that must be somehow perceived by the user. No feature of Withnall or Fields provides the capability of transmitting programming material from a remote site back to a user. Furthermore, this would not be possible without performing an additional inventive step.

In sum, any attempt to combine Withnall, Fields, and Li to create the present invention would be unsuccessful and fails to provide the flexible, updateable system including a system for obtaining and surveying correlated programming material of the claimed invention as opposed to a comparison of the identity of a printed code with a code stored in a database. Moreover, the dynamic programming material of the claimed invention is not disclosed by the combination of these references.

In view of the foregoing, base claims 168, 296, and 299 cannot be unpatentable over Withnall, Fields, and Li. The remaining rejected claims are dependent on these claims and contain all of the limitations of their respective base claims. Therefore, these dependent claims are also not unpatentable over these references.

In all subsequent rejections, the Examiner noted the deficiencies of the Withnall, Fields, and Li combination regarding matter disclosed in dependent claims and appended various other references including Roberts, Malec, Bravman, Waterbury, Tannehill, Schach, and Morales to the combination in order to provide the additional features of the dependent claims. However, the combination of Withnall, Fields, and Li has been shown to be not only improper, but also to lack the disclosure of each and every

element of the base claims. Because this combination is improper and incomplete, any further combination of references with Withnall, Fields, and Li would also be improper. Thus, Applicants respectfully submit that all remaining rejections have also been overcome and should be withdrawn.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and favorable action is accordingly solicited.

Respectfully submitted,

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